

Rejections Under 35 U.S.C. §103(a)

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,488,433 (Washino et al.) in view of U.S. Patent No. 5,715,018 (Fasciano et al.). Claims 1-8 were further rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,579,239 (Freeman et al.) in view of U.S. Patent No. 5,488,433 (Washino et al.). Applicants respectfully traverse these rejections.

***Rejection of Claims 1-8 over Washino in View of Fasciano***

Applicants respectfully traverse the rejection of claims 1-8 over Washino in view of Fasciano for several reasons. First, Applicants respectfully assert that Fasciano is non-analogous art. In addition, Applicants respectfully assert that one of ordinary skill would not be motivated to combine Washino with Fasciano as suggested in the Office Action.

1. Fasciano is Non-Analogous Art

Applicants traverse the rejection of claims 1-8 over Washino in view of Fasciano because Fasciano is non-analogous art to the claimed invention. In order for a reference to be considered analogous art, "the reference must either be in the field of Applicants endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." See MPEP§2141.01(a) (citing *In re Oetiker*, 977F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Fasciano satisfies neither of these requirements.

First, Fasciano is not directed to the field of endeavor of Applicants' invention. Specifically, Fasciano describes a digital audio/visual insertion and broadcast system (abstract). Fasciano, at col. 2, lines 20-22, teaches that audio/video information originally recorded on a linear tape may be stored in a file server 14. The file server 14 is typically a free standing extensive mass storage device employing either magnetic or optical storage media (col. 2, lines 20-36). These components, and others, may be located at the main business location of the cable operator (col. 2, lines 20-22).

In contrast, the present invention is related to a digital motion picture camera that may directly record audio/visual information into a non-linear storage medium and that is portable for use by an individual. Thus, one of ordinary skill would not look to Fasciano which teaches using linear tape as an input in a non-portable environment when designing a portable digital motion picture camera as recited in Applicants' claims.

Furthermore, Fasciano is not pertinent to the particular problem with which the present invention is concerned. One problem in creating a system according to the present invention is to have enough storage capacity *in the camera* in order to store more than trivial amount of broadcast quality video. In Fasciano, the fact that the images may be stored in any type or size of data storage medium removes this constraint because there is no physical limit on storage space. Accordingly, when the issues facing the development of a camera that is transportable by an individual and that can store a meaningful amount of video information is encountered, one of ordinary skill would not consider the system of Fasciano that may utilize large memories that are not transportable.

In light of the above, Applicants respectfully assert that Fasciano is non-analogous to the claimed invention. As such, the rejection of claims 1-8 which rely on Fasciano are improper and should be withdrawn.

## 2. One of Ordinary Skill Would Not Be Motivated to Combine Washino and Fasciano

The Examiner asserts that one of ordinary skill would combine the teachings of Washino with Fasciano. Applicants respectfully disagree.

In order to show that one of ordinary skill in the art would be motivated to combine references, an "examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). "Evidence of a suggestion, teaching, or motivation to combine ... must be clear and particular." *See In re Dembiczak*, Slip op. 98-1498

(Fed. Cir. April 28, 1999) (citations omitted). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See Id.* The Examiner has simply not met this burden in the Office Action.

Specifically, the Examiner asserts that it would have been obvious to combine the apparatus of Washino with the converting and storing means of Fasciano “in order to capture and storing the high quality picture for later viewing.” However, the Examiner has not cited any evidence to support this position. Applicants presume that the Examiner is contending that one of ordinary skill would want to view a high quality picture. Without modification, the system of Washino already provides a means for viewing a high quality image, namely, the tapes (e.g., DAT) that record at the lower data-compression-ratio (col. 3, lines 34-40). Because Washino already provides means for viewing a high quality image, one of ordinary skill in the art would not be motivated to look to a reference such as Fasciano to provide for such a capability.

Furthermore, the Examiner has failed to provide evidence of a reason from the nature of the problem being solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art, as to why one of ordinary skill in the art would combine the references. *See Rouffet*, 47 U.S.P.Q.2d at 1458. Specifically, the only motivation provided by the Examiner is to store “the high quality picture for later viewing.” As discussed above, Washino already has means for storing high quality pictures for later viewing. Fasciano is not directed to a system implemented in a digital motion picture camera and provides no motivation to implement the system in a digital motion picture camera. Thus, the prior art neither provides the requisite motivation nor provides evidence of the Examiner’s alleged motivation.

Additionally, the Examiner has not relied on evidence of either the problem being solved (the Examiner has not even identified the problem) or the knowledge of one of ordinary skill in the art as to why one of ordinary skill would combine the references. As such, Applicants respectfully assert that the combination of Washino and Fasciano is improper and should be withdrawn.

Applicants also assert that only motivation, of record, to combine Washino and Fasciano is Applicants specification. Particularly, Washino is directed to an audio/video production system that is implemented on a PC-based platform (abstract). The system utilizes specially modified cameras that provide digitally data compressed audio and video program material in two formats (abstract). The broadcast quality images are stored on a linear tape.

Fasciano describes a digital audio/video insertion and broadcast system (abstract). The system takes audio/video source information and digitizes, compresses, and stores the information on a random access medium (abstract). The source information comes from a linear tape read by the VTR 10 (FIG 1).

There is no teaching or suggestion in either of these references that the information stored in a portable device come directly from a motion picture camera to the means digitizing, compressing, and storing. The only reference of record which recites that the broadcast quality motion video be converted in the camera instead of outside the camera (the Examiner admitted that Washino does not teach broadcast quality video be converted and stored in a random access memory) is Applicants specification. For this additional reason, Applicants assert that the combination of Washino and Fasciano is improper and should be withdrawn.

### ***Rejection of Claims 1-8 over Freeman in View of Washino***

Applicants respectfully traverse the rejection of claims 1-8 over Freeman in view of Washino for several reasons. Applicants respectfully assert 1) that Freeman is non-analogous art and 2) that one of ordinary skill in the art would not be motivated to combine Freeman and Washino.

#### **1. Freeman is Non-Analogous Art**

Applicants respectfully traverse the rejection of claims 1-8 over Freeman in view of Washino because Freeman is non-analogous art. Particularly, Freeman is directed to a remote video transmission system for digitizing and compressing an audio/visual signal. The signal is

input to the remote unit from a video camera at a remote location (col. 2, lines 59-61). The remote unit is a personal computer, which may be portable and may have one or more computer interfaces and a corresponding number of cellular phones (col. 2, lines 61-63). The remote unit captures, digitizes, and compresses the video signal into a datafile (col. 2, line 67 to col. 3, line 1). Thus, Freeman is a personal computer that is separate from the camera and that may digitize video information. In contrast to the claimed invention which is a camera that records video information directly to a digital format, a personal computer, whether portable or not, is not a camera. There is no reason supported by evidence, why one would look to personal computers to solve problems of recording on a camera. As such, Applicants assert that Freeman is non-analogous art and the rejections of claim 1-8 that rely upon Freeman should be reconsidered and withdrawn.

## 2. One of Ordinary Skill Would Not Combine Freeman and Washino

As discussed above, in order to combine two references, the Examiner must show evidence of reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *See In re Rouffet*, 47 U.S.P.Q.2d at 1458. The Examiner has failed to meet this burden.

The Examiner asserts that a “recording apparatus having [sic] processing and recording/reproducing part for recording motion picture and a camera part for processing the [sic] object to a motion picture signal and wherein the camera part is mounted to the recording part is well known in the art as taught [sic] by Washino.” From this statement, the Examiner then asserts that it would have been obvious to combine Freeman and Washino. Applicants disagree with these assertions.

First, Washino does not teach that one should integrate a system that has the ability to produce broadcast quality images into a camera. Quite to the contrary, and as discussed above, Washino teaches that broadcast quality images should be produced from the linear video tape at a

location *external* to the camera. This teaching is exactly what Freeman teaches. Thus, both references teach digitizing broadcast quality signals *external* to the camera. As such, the Examiner has not shown in either reference where or why one would be motivated to provide broadcast quality abilities in a portable motion picture camera.

Second, the Examiner's stated motivation for combining Freeman and Washino is to create an apparatus that is easily handled and can capture the motion picture for storing, editing and reading the motion picture. However, the Examiner has not cited any evidence that the prior art suggests that such an apparatus is desirable. Actually, both of these references explicitly teach that these images should be edited and stored at a location external to the camera. For instance, in Freeman the information is captured, compressed, and digitized in the remote unit 2 (e.g., a personal computer) (col. 4, lines 8-10). Similarly, in Washino, the broadcast quality video images are recorded on a linear recording means (e.g., video tape) which are edited in an off-line digital video editing system personal computer external to the camera (col. 5, lines 49-51).

Thus, because both Washino and Freeman both teach using personal computers external to the camera, one of ordinary skill would not combine the references if faced with the problem of creating a camera that may record directly to digital memory in the camera. The only motivation of record for such a combination is Applicants' specification and, therefore, the Examiner has used hindsight to pick and choose elements from the prior art based upon Applicants' disclosure. Accordingly, the rejection of claims 1-8 over Freeman, in view of Washino is improper and should be withdrawn.

#### Conclusion

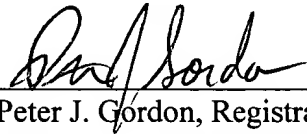
In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. A notice to this effect is respectfully requested. Should further

questions arise concerning this application, the Examiner is invited to call the Applicants' attorney at the number listed below.

Respectfully submitted,

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